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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/18/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/910,716

Applicant(s)

HARADA ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/07 has been entered.

***Response to Amendment***

2. In the amendment filed 2/6/07, the following has occurred: claims 1-7 and 9-12 and 20 have been amended. Claims 13-19 have been amended but remain withdrawn. It is the Examiner's understanding from status identifiers presented in the claim amendments along with the remarks that it is Applicant's intention to amend claims 13-19 in an effort to place them in condition for rejoinder upon allowance of the claims from which they depend. Therefore, claims 13-19 will remain withdrawn but upon allowance of the claims from which they depend, claims 13-19 will be rejoined and examined on the merits.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5-6, 9-12, and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-3, 5-6, 9-12, and 20 recite the phrase "buyer and/or seller." It is unclear whether this phrase requires both the buyer and the seller or whether the buyer and seller are

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only required in the alternative. For examination purposes, the Examiner will interpret this phrase as "at least one of the buyer and the seller."

6. Claims 4 and 7 are rejected for the same reasons as given above through dependency.

7. In addition, claim 20 recites the phrase "the electronic commerce information." Since there is no previous recitation of "electronic commerce information," this phrase lacks antecedent basis in the claim.

8. Claim 20 also recites the phrase "said transmitted transactional information." However, due to the claim amendments, there is now insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-7, and 9-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177 in view of Furusawa et al., U.S. Patent No. 6,934,738.

11. As per claim 1, DiMattina teaches an insurance task processing method comprising: checking, by a third party, electronic information distributed within a computer network between a buyer and a seller to judge whether a solicitation-related keyword is included in the electronic information (see column 3, lines 56-62 and column 4, lines 12-14, the Examiner interprets data regarding items the purchaser wishes to buy to be a form of solicitation-related keyword; it is also noted that the entire transaction may be carried out by the retailer's server, the insurance

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server (i.e. third party), or both); and distributing solicitation-to-insurance information to at least one of the buyer and the seller having exchanged the electronic information with each other, when judged by the third party that the solicitation-related keyword is included in the electronic information (see column 3, line 63 - column 4, line 21). DiMattina does not explicitly teach that the electronic information is cross-checked with a word table in which a solicitation-related keyword as a clue of solicitation-to-insurance is registered. Furusawa teaches a method of processing messages in an electronic network in which messages are cross-checked with a word table where keywords are registered and performing associated programs based on identified keywords contained in the messages (see column 5, lines 21-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such keyword lookup table functionality into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing uniformity in the message processing of DiMattina (see column 1, lines 37-42 of Furusawa).

12. As per claim 2, DiMattina in view of Furusawa teaches the method of claim 1 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information to at least one of the buyer and the seller when at least one of the buyer and the seller has not yet subscribed to insurance (see column 3, line 58 – column 4, line 3, since the insurance is offered for the particular transaction, the buyer has not yet subscribed to insurance).

13. As per claim 3, DiMattina in view of Furusawa teaches the method of claim 2 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information to at least one of the buyer and the seller even when at least one of the buyer and the seller has already subscribed to insurance, if the insurance is invalid, or if at least one of the buyer and the seller has experienced an encounter with an accident related to

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electronic commerce in the past (see column 3, line 58 – column 4, line 3, since DiMattina does not give any restrictions on when the insurance information is distributed, it would still be distributed under these conditions).

14. As per claim 4, DiMattina teaches the method of claim 1 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information from an insurer selected corresponding to contents of the electronic information (see column 3, lines 47-55).

15. As per claim 6, DiMattina teaches an insurance task processing method comprising: an inputting transactional information in a transaction related to electronic commerce between a buyer and a seller (see column 3, lines 56-58); checking, by a third party, the transmitted transactional information between the buyer and the seller to judge whether a solicitation-related keyword is included in the transmitted transactional information (see column 3, lines 56-62 and column 4, lines 12-14); and transmitting solicitation-to-insurance information to the at least one of the buyer and the seller when judged, by the third party, that the solicitation-related keyword is included in said transmitted transactional information (see column 3, line 58 – column 4, line 3). DiMattina does not explicitly teach that the electronic information is cross-checked with a word table in which a solicitation-related keyword as a clue of solicitation-to-insurance is registered. Furusawa teaches a method of processing messages in an electronic network in which messages are cross-checked with a word table where keywords are registered and performing associated programs based on identified keywords contained in the messages (see column 5, lines 21-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such keyword lookup table functionality into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a

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feature for the purpose of providing uniformity in the message processing of DiMattina (see column 1, lines 37-42 of Furusawa).

16. As per claim 7, DiMattina in view of Furusawa teaches the method of claim 6 as described above. DiMattina further teaches judging whether a transactional keyword has been included in said input transactional information (see column 3, line 56-58, the Examiner interprets the data regarding items a purchaser wishes to buy to be a form of "keyword" as recited in the claim); and notifying a risk related to the electronic commerce, when said transactional keyword is judged to be included in the transactional information (see column 3, line 58 – column 4, line 3, the Examiner interprets the "guarantees" to be a form of notification of risk related to the electronic commerce).

17. Claims 10, and 11 recite substantially similar computer medium and system limitations to method claim 1 and, as such, are rejected for similar reasons as given above.

18. Claims 9 and 12 recite substantially similar computer medium and system limitations to method claim 6 and, as such, are rejected for similar reasons as given above.

19. As per claim 20, DiMattina teaches an insurance task processing method comprising: judging, by a third party, whether a solicitation-related keyword is included in electronic commerce information exchanged between a buyer and a seller (see column 3, lines 56-62); and transmitting solicitation-to-insurance information to at least one of the buyer and the seller, when said judging, by the third party, determines that the solicitation-related keyword is included in said transmitted transactional information (see column 3, line 63 - column 4, line 21).

DiMattina does not explicitly teach that the electronic information is cross-checked with a word table in which a solicitation-related keyword as a clue of solicitation-to-insurance is registered.

Furusawa teaches a method of processing messages in an electronic network in which messages are cross-checked with a word table where keywords are registered and performing

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associated programs based on identified keywords contained in the messages (see column 5, lines 21-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such keyword lookup table functionality into the system of DiMattina.

One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing uniformity in the message processing of DiMattina (see column 1, lines 37-42 of Furusawa).

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177 in view of Furusawa et al., U.S. Patent No. 6,934,738 and further in view of Margoscini et al., U.S. Patent no. 7,003,482.

21. As per claim 5, DiMattina in view of Furusawa teaches the method of claim 1 as described above. DiMattina further teaches receiving insurance premium information which has been calculated corresponding to a price included in the electronic information (see column 5, lines 23-26); calculating the sum of the insurance premium indicated by the received insurance premium information and the price (see column 5, lines 26-29); and presenting the calculated insurance premium and the calculated sum to both of the buyer and seller (see column 4, lines 14-17 and column 5, lines 44-50).

22. DiMattina does not explicitly teach the insurance premium information is calculated based on a discount insurance premium rate. However, Margoscini teaches a business middleware system for implementing business policy changes including implementing insurance premium discounts (see column 11, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a



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feature for the purpose of easily implementing business policy changes, such as implanting insurance premium discounts (see column 2, lines 34-41).

***Response to Arguments***

23. In the remarks filed 2/6/07, Applicant argues in substance that (1) DiMattina only teaches that the seller monitors the electronic information to determine to distribute solicitation-to-insurance information; (2) DiMattina only teaches distributing solicitation-to-insurance information to a buyer and not to the buyer and/or seller as claimed; (3) there is no motivation to combine Furusawa with DiMattina.

24. In response to Applicant's argument (1), the Examiner respectfully disagrees that DiMattina only teaches that the seller monitors the electronic information. The process of monitoring the electronic information and distributing solicitation-to-insurance information is described at column 3, line 56 – column 4, line 2. This portion of DiMattina does not explicitly disclose what entity monitors the fact that the buyer has submitted items to purchase and, subsequently, distributes the solicitation to insurance information. However, at column 4, lines 12-14, it is indicated that the "entire transaction is handled by the retailer's server or the insurance server (or both)." Moreover, it is noted that the entire insurance process is implemented by a cooperation between the retailer and the insurer in which the retailer's website is modified to implement a call to the insurance providers web address in exchange for payment (see column 3, lines 48-55). Therefore, it is respectfully submitted that, in some embodiments, the insurance provider (i.e. a third party) performs the functions of monitoring and distributing as claimed.

25. In response to Applicant's argument (2), although DiMattina does not explicitly teach distributing solicitation-to-insurance information to the buyer, this is not required by the claims

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based on the interpretation given above in the 112 rejections. Therefore, the Examiner does not find this argument to be persuasive.

26. In response to Applicant's argument (3), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response, the Examiner respectfully submits that motivation to combine the references has been provided as suggested by Furusawa. It appears that Applicant is arguing that because Furusawa describes a preferred embodiment of cross-checking emails, there is no motivation to combine. However, it should be noted that the Examiner has merely relied upon the teachings of Furusawa for cross-checking electronic information with a table of registered words. The Examiner has not relied upon Furusawa for any particular emailing capabilities. Therefore, the Examiner does not find this argument to be persuasive.

### ***Conclusion***


27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/13/07

  
**C. LUKE GILLIGAN**  
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